



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/650,830      | 08/29/2003  | Hisashi Tsubata      | Q77026              | 8024             |

23373 7590 07/12/2005

SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

BERNATZ, KEVIN M

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1773

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/650,830

Applicant(s)

TSUBATA ET AL

Examiner

Kevin M. Bernatz

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendments to claims 13 and 15, filed on April 22, 2005, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Request for Continued Examination***

3. The Request for Continued Examination (RCE) under 37 CFR 1.53 (d) filed on April 22, 2005 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Claim Rejections - 35 USC § 103***

4. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagao et al. (JP 2000-331341 A) in view of Aki et al. (U.S. Patent No. 6,438,074) and Shipman (U.S. Patent No. 6,337,119 B1), and as evidenced by Schwarz et al. (U.S. Patent No. 5,229,895). See provided Machine Translation of JP '341 A.

Nagao et al. as evidenced by Schwarz et al. are relied upon as described in Paragraphs 3 – 6 of the Office Action mailed November 24, 2004.

Regarding claims 13 and 14, Nagao et al. fail to disclose the limitation “after performance of the magnetic transfer, wear of a surface of the master medium bearing

Art Unit: 1773

data to be transferred and marks generated after performance of the magnetic transfer on the surface of the master medium, are remedied by the grinding”.

However, Aki et al. teach that it is known in the art to regrind master media after transferring data from the master media (*col. 2, lines 26 – 31*) and Shipman also teach that it is known to polish/grind the surface of a master media to fix any mechanical damage that occurs (*col. 2, lines 65 – 67*).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Nagao et al., as evidenced by Schwarz et al., to meet the claimed method of use limitation “after performance of the magnetic transfer, wear of a surface of the master medium bearing data to be transferred and marks generated after performance of the magnetic transfer on the surface of the master medium, are remedied by the grinding” as taught by Aki et al. and Shipman since both references teach that it is known in the art to regrind/polish master media after use to account for any defects or wear on the surface of the media in order to prolong the life of the master media.

5. Claims 13 – 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashi et al. (WO 00/65579) in view of Nagao et al. (JP ‘341 A), Aki et al. (‘074 B1) and Shipman (‘119 B1). See U.S. Patent 6,665,133 B1, which is the U.S. equivalent of WO ‘579.

Hashi et al. and Nagao et al. are relied upon as described in Paragraphs 8 – 18 of the Office Action mailed November 24, 2004.

Regarding claims 13 and 14, neither Hashi et al. nor Nagao et al. explicitly disclose the limitation “after performance of the magnetic transfer, wear of a surface of the master medium bearing data to be transferred and marks generated after performance of the magnetic transfer on the surface of the master medium, are remedied by the grinding”.

However, Aki et al. teach that it is known in the art to regrind master media after transferring data from the master media (*col. 2, lines 26 – 31*) and Shipman also teach that it is known to polish/grind the surface of a master media to fix any mechanical damage that occurs (*col. 2, lines 65 – 67*).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Hashi et al. in view of Nagao et al., as evidenced by Schwarz et al., to meet the claimed method of use limitation “after performance of the magnetic transfer, wear of a surface of the master medium bearing data to be transferred and marks generated after performance of the magnetic transfer on the surface of the master medium, are remedied by the grinding” as taught by Aki et al. and Shipman since both references teach that it is known in the art to regrind/polish master media after use to account for any defects or wear on the surface of the media in order to prolong the life of the master media.

***Response to Arguments***

**6. The rejection of claims 13 and 14 under 35 U.S.C § 102(b) – Nagao et al.**

The above noted rejection has been withdrawn because applicant(s) amendment(s) have set forth new limitations (e.g. “after performance of ... remedied by the grinding”) no longer anticipated, nor rendered obvious, by the above noted rejection. As such, applicants’ arguments have been considered but are moot in view of the new ground(s) of rejection.

**7. The rejection of claims 13 - 16 under 35 U.S.C § 103(a) – Hashi et al. in view of Nagao et al.**

The above noted rejection has been withdrawn because applicant(s) amendment(s) have set forth new limitations (e.g. “after performance of ... remedied by the grinding”) no longer anticipated, nor rendered obvious, by the above noted rejection. As such, applicants’ arguments have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

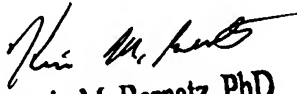
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M. Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

Art Unit: 1773

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB  
July 8, 2005

  
Kevin M. Bernatz, PhD  
Primary Examiner